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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,782	08/22/2001	Jaswinder Pal Singh	25961-708	9031

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EXAMINER

NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 02/12/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

926

Office Action Summary

Application No.

09/935,782

Applicant(s)

SINGH ET AL.

Examiner

Merilyn P Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

1. Claims 1-13 are pending in this office action.
2. This application is a continuation-in-part of U.S Application No. 09/933888 filed August 20, 2001 and U.S Application No. 09/933885 filed August 20, 2001 which claims the priority to Provisional Application No. 60/226479 filed on August 20, 2000, Provisional Application No. 60/227125 filed on August 20, 2000, and Provisional Application No. 60/227875 filed on August 20, 2000.

Acknowledges

3. Receipt is acknowledged of the following items:
 - o The preliminary amendments have been considered.

Abstract

4. The abstract of the disclosure is objected to because the abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. Also, the language should be clear and concise. For example, it's unclear what is the meaning of "relates to one more populating, indexing, and searching a database". Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claims 7 and 12 are objected to because of the following informalities: These claims are duplicated each other. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Regarding claims 1, 4, and 9, the language of these claims is not clear and concise. One skilled in the art clearly would not know how to use the claimed invention. For example, the step for “accessing zero or more documents” does not make sense in view of functionality of the invention since accessing zero document does not mean anything, also the same for the limitation of “zero or more data” in claims 4 and 9. The term “partly responsive to” is obscure. It’s unclear what level of responses needed to complete functions.

Claims 2-3, 5-8, and 10-13 are rejected for being dependent from rejected base claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-13, to be statutory a process must be directed to a practical application in the technological arts. The claimed method steps of claims 1-13 are directed to a method for searching resources. The claimed method steps for searching resources can be

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performed by a plurality of manual systems which are unrelated or tight to a technical art, environment, or machine. For example, the process of moving or taking out parts of physical copies of patent applications and searching for information needs by browsing through plurality of physical copies of applications reads on the present invention per claim 66. Applicant must use technology to achieve the function of the method steps to ensure the claimed invention is directed to statutory subject matter.

Claims 2-3, 5-8, and 10-13 are rejected for being dependent from rejected base claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mandler (US 2001/0049675).

Regarding claim 1, Mandler discloses a method of searching resources (See Abstract, Figs. 6-10, paragraph [0015, 0016]), comprising:

- receiving a search query (See Paragraphs [0045, 0050, 0068, and 0070], wherein file request includes partial and complete queries);

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- accessing zero or more documents and one or more subsets of one or more documents (See Paragraphs [0045, 0068] , wherein the accessing documents and subset of documents is performed using the index), the subsets having been extracted from the one or more documents prior to receiving the search query, the subsets extracted at least partly responsive to one or more views, the one or more views defined independently of the search query (See Paragraphs [0045, 0072], wherein every time a file is added to the file structure 12, it must be parsed to retrieve meaningful information that made the search functions of an XML document repository possible, and wherein the retrieved information including elements, attributes encoded in XML documents);
- at least partly responsive to the search query, identifying zero or more documents and at least one of one or more subsets of one or more documents, the search query used as a criterion for identifying at least one of the one or more subsets (See Paragraphs [0088-0093]).

Regarding claims 4 and 9, Mandler discloses a method of searching resources including markup language (See Abstract, Figs. 6-10, paragraph [0015, 0016]), comprising:

- receiving a search query (See Paragraphs [0045, 0050, 0068, and 0070], wherein file request includes partial and complete queries); and in response to the search query, Mandler teaches identifying sequences of views that can be applied to one or more markup language documents as sequence of displays of Figures 6 through 10, wherein each view including data and instructions specifying methods for

selecting one or more subsets of the one or more documents as illustrated in Figures 6-10 and Paragraphs [0088-0093].

Regarding claims 2, 7, and 12, Mandler discloses wherein if no appropriate view is accessed, then storing one or more subsets of one or more documents, the subsets determined by analysis one or more documents (See Paragraphs [0071-0072]).

Regarding claims 3, 8 and 13, Mandler discloses wherein one or more views includes one or more documents and one or more selections, one or more selections including one or more subsets of one or more documents (See Paragraph [0092]).

Regarding claims 5 and 10, Mandler discloses wherein the zero or more data includes one or more documents and one or more selections of the one or more documents (See Paragraph [0092]).

Regarding claims 6 and 11, Mandler discloses wherein each sequence of one or more views includes at least a plurality of one or more views, at least one view of the plurality of one or more views includes one or more links to one or more views of the plurality of one or more views, the one or more links allowing at least two of the plurality of one or more views to be accessed sequentially (See Figs 6-10).

Conclusion

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kravets U.S Patent No. 6,363,377 discloses search data processor.

Husick U.S Patent No. 5,717,914 discloses method for categorizing documents into subjects using relevance normalization for documents retrieved from an information retrieval system in response to a query.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



MN
February 6, 2004

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